

REMARKS

By this amendment, all claims have been canceled in favor of new claims 20-22. Currently, it is these claims that are before the Examiner for consideration on their merits.

In review, the Examiner has maintained the rejection of the previously presented claims. The claims were divided essentially into two groups. One group defined the invention such that the adhesive applied to the elastic member had an undulation height equal to the circumferential length of the elastic member. Another group defined the invention in terms of the undulation height of the adhesive exceeding the circumferential length of the elastic member.

In response to the Applicant's last submission, the Examiner continued to cite Van Eperen and Kwok '375 to reject the claims. Regarding Van Eperen, the Examiner contended that this patent taught that the adhesive had an undulation that was equal to or greater than the circumferential length of the elastic. Regarding Kwok '375, it was contended that this patent at least taught that the undulation height followed a path at least equal to the circumferential length of the elastic.

In the "Response to Arguments" section of the Office Action, the Examiner reiterates the position that both Kwok and Van Eperen teach that the adhesive follows a path that at least touches the longitudinal line recited in the claims. Put in the context of the rejection and the discussion of the height of the undulation and length of the circumference of the elastic member, touching the longitudinal line is interpreted to be the same as the height of undulation to be the same as the circumferential length of the elastic member.

In order to simplify the issues of patentability, all pending claims have been canceled in favor of new independent claim 20 and its dependent claims 21 and 22. The dependent claims parallel original claims 3 and 5. New claim 20 is specifically directed to the embodiment as originally claimed wherein the undulation height exceeds the circumferential length of the elastic member. More particularly, claim 20 is written to describe the path of the adhesive as shown in Figure 2, starting at a point on the longitudinal line 17, point P, and terminating on the same line at point X. Important to claim 20 is the limitation that the path cross over the first longitudinal line twice when traversing the elastic member between the second lines. Claim 20 also requires that the cycle path cross over the first line again prior to arriving at the second point and start of a new cycle

path.

As critical, claim 20 also defines the step of bringing the elastic member and adhesive into contact with the topsheet and backsheet such that the first longitudinal line 17 faces the inner side of the topsheet with the second and diametrically opposed line 18 facing the inner side of the backsheet.

Turning now to the Kwok '375 and Van Eperen, it is respectfully submitted that neither of these references teach the cycle path as defined in claim 20, and the rejection based on 35 U.S.C. § 102(b) must be withdrawn. Both Kwok '375 and Van Eperen drape the adhesive over the elastic member, and therefore it is informative to compare claim 20 and Figure 2 from this perspective. If one were to start at point D of Figure 2 as the start of a drape cycle, the underside line of Kwok '375 and Van Eperen would coincide with longitudinal line 17 of Figure 2.

In the rejection, the Examiner concluded that in the draping method of either Kwok '375 or Van Eperen, the adhesive would be draped such at it would at least touch the longitudinal line running along the bottom of the elastic, and it was this interpretation that supported the rejection that the prior art taught an undulation height equal to the circumferential length of the elastic member. Since claim 20 is limited to the embodiment wherein the undulation height is greater than the circumferential length of the elastic member, the rejection in this regard is now moot.

The real issue in light of the cancellation of pending claims and submission of claim 20 is whether either or both of Kwok '375 and Van Eperen could be interpreted to encompass the embodiment wherein the undulation height of the adhesive is greater than the circumferential length of the elastic member. In the context of claim 20 as presently drafted, the question is whether the cycle path of either Kwok '375 or Van Eperen can be interpreted, either from an anticipation or obviousness standpoint, to teach or suggest the claimed cycle path.

From an anticipation standpoint, it is contended that there is no factual basis to conclude that the adhesive of Kwok '375 and Van Eperen would cross the underside longitudinal line of the elastic member, and then cross back as now defined in claim 20. The Examiner has not been able to point to any disclosure in either reference that explicitly teaches such a configuration of adhesive. Col. 5, lines 1-15 of Kwok '375 has been discussed as a basis to reject the claims. However, the reference to an "underside 36 of the strand 30" does not mean that the strand would necessarily

cross under the bottom longitudinal line of the elastic member. “Underside” can be interpreted to mean that it is on an underside of the elastic without crossing over the underneath line. Van Eperen offers no more than Kwok ‘375 in terms of the disclosure of the draping embodiment. In the action, the Examiner contended that Van Eperen formed a droop that extended below the elastic, and when measuring the length of the droop, the undulating height of the adhesive would be equal to or greater than the circumference of the elastic member. However, this analysis does not stand up in light of new claim 20 and the requirement of crossing over the first longitudinal line and then crossing back over it. Regardless of whether Van Eperen has a droop or not, this feature of claim 20 is still lacking.

Moreover, since Kwok ‘375 and Van Eperen apply the adhesive by merely draping it over the elastic, how would the adhesive go beyond the underside longitudinal line? In effect, the adhesive would have to move upward against gravity, and neither Kwok ‘375 or Van Eperen disclose any apparatus features to have this happen. Therefore, there is no basis to allege that either of these patents establishes a *prima facie* case of anticipation against new claim 20.

In addition, there is no basis to conclude that either Kwok ‘375 or Van Eperen somehow establishes a *prima facie* case of obviousness. For this rejection to stand, the Examiner would have to contend that there is some motivation in the prior art to extend the adhesive of either Kwok ‘375 or Van Eperen such that it would follow a cycle path as set forth in new claim 20. Lacking any suggestion in Kwok ‘375 or Van Eperen regarding the adhesive path crossing the underside line, and, as importantly, any means in either reference to accomplish such a modification, the Examiner has no legitimate basis to make such an allegation of obviousness. To do so would be the hindsight reconstruction of the prior art in light of Applicant’s disclosure, and such action would not be sustainable on appeal.

To summarize, it is now contended that neither Kwok ‘375 nor Van Eperen anticipates or renders obvious claim 20, and this claim along with its dependent claims 21 and 22 are now in condition for allowance.

While this Amendment is presented after final, it is respectfully submitted that it resolves the issues raised by the Examiner in the outstanding Office Action and places the application in condition for allowance. Moreover, it is strenuously asserted that no new issues are raised by the

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submission of this amendment. Applicant and the Examiner have gone through numerous rounds of rejections, interviews, and responses in an effort to distinguish the claims from the applied prior art. Moreover, claims 14 and 15 in the prior response addressed the cycle path that is redefined in claim 20, and this is not a new concept requiring additional searching or further consideration on the Examiner's behalf. Therefore, and at the very least, this Amendment should be entered for purposes of appeal if the Examiner continues to rely on Kwok '375 and Van Eperen to reject the claims.

Accordingly, the Examiner is respectfully requested to enter this Amendment, examine this application and pass claims 20-22 onto issuance.

If the Examiner believes that an additional interview would expedite the prosecution of this application, the Examiner is requested to telephone the undersigned at 202-835-1753.

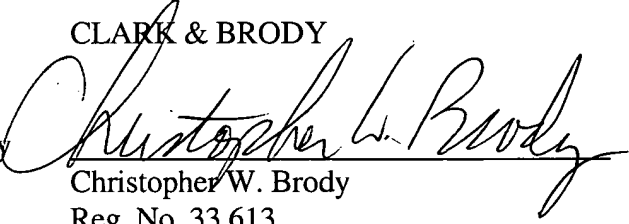
Again, reconsideration and allowance of this application are respectfully solicited.

Please charge deposit account no. 50-1088 for any shortages in fees in connection with this filing, and credit any overpayments as well.

Respectfully submitted,

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